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Paper No. 16
csl

UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re Toma Industries, Inc.

Serial No. 75/524,079

Jay H. Geller, Esquire, for applicant.

Renee McCray, Trademark Examining Attorney, Law Office 110
(Chris A.F. Pedersen, Managing Attorney).

Before Simms, Quinn and Rogers, Administrative Trademark
Judges.

Opinion by Simms, Administrative Trademark Judge:

Toma Industries, Inc. (applicant), a California corporation, has appealed from the final refusal of the Trademark Examining Attorney to register the mark MAGIC LASH for "eye liner and synthetic fibers applie[d] to eyelashes to increase length and fullness."¹ In the application, applicant disclaimed the word "LASH" apart from the mark as shown.

¹Serial No. 75/524,079, filed July 23, 1998, based upon applicant's bona fide intention to use the mark in commerce. The original description of goods in the application was "mascara, eye-liner and synthetic fibers for lengthening the eyelashes."

The Examining Attorney has refused registration under Section 2(d) of the Act, 15 USC §1052(d), on the basis of Registration No. 1,833,605, issued May 3, 1994, Section 8 affidavit accepted, for the mark CILS MAGIQUE covering "cosmetics, namely mascara." In the registration it is indicated that the mark "CILS MAGIQUE" translates to "magic eyelashes."

Applicant and the Examining Attorney submitted briefs but no oral hearing was requested.

We affirm.

It is applicant's position that the doctrine of foreign equivalents should not be applied in this case because the marks create different commercial impressions and because applicant believes that it is "highly unlikely" that a consumer will translate registrant's mark. Brief, 2. Rather, it is applicant's position that the consumer will only remember that the mascara sold under the registered mark is from Chanel, Inc., the well-known cosmetics company. While acknowledging that mascara, eyeliner, and synthetic fibers for eyelashes are "impulse" purchase items, applicant contends that registrant's goods would appeal to upper-income purchasers and would be bought at Chanel boutiques in upscale department stores. Applicant also has argued, Amendment, filed July 24, 2000,

p. 2, that mascara and eyeliner are not closely related products. Finally, in its brief, applicant contends that the mark MAGIC appears in at least 220 registered marks, and that the mark MAGIC is "weak" in relation to Class 3 goods (soaps, perfumery, essential oils, cosmetics, hair lotions, etc.).

We agree with the Examining Attorney, however, that confusion is likely in this case. First, the doctrine of foreign equivalents requires that foreign words from a language known to an appreciable segment of American consumers be translated into English before a comparison of the marks is made. See, for example, *In re Perez*, 21 USPQ2d 1075 (TTAB 1991); *In re American Safety Razor Co.*, 2 USPQ2d 1459 (TTAB 1987) and *In re Ithaca Industries, Inc.*, 230 USPQ 702 (TTAB 1986). Here, according to the registration and a copy of the pertinent page from a French-English dictionary,² the French words "cils magique" are translated as "magic eyelashes." The Examining Attorney has also made of record evidence that the word "lash" means "eyelash." It is the Examining Attorney's position, therefore, that the registered mark CILS MAGIQUE (meaning "magic eyelashes") is equivalent in connotation

²Cassell's French-English English-French Dictionary (1981). The French word "cil" is translated as "eyelash."

and commercial impression to applicant's mark MAGIC LASH and that these marks are otherwise similar in appearance and sound. We agree.

It is also clear, as the Examining Attorney has argued, that the dominant part of each mark is the word "MAGIQUE" on the one hand and "MAGIC" on the other, because "EYELASHES" and "LASH" are descriptive or generic terms for cosmetics for the eyes and eyelashes and are, therefore, entitled to less weight in the likelihood-of-confusion analysis.

Concerning the goods, registrant's mascara (a cosmetic applied to darken the eyelashes) is very closely related to applicant's eyeliner and synthetic fibers applied to eyelashes. Moreover, the Examining Attorney has made of record 25 third-party registrations showing that numerous companies have registered a mark covering both eyeliner and mascara. Further, the goods of both applicant and registrant may serve the same function of lengthening the eyelashes.

As both attorneys seem to acknowledge, the respective goods can be relatively inexpensive. Therefore, purchasers of such goods are held to a lesser standard of care in the purchasing decision.

Finally, even if the registered mark may be considered somewhat suggestive and weak,³ it is nevertheless entitled to protection from the registration of a very similar mark for closely related goods.

Decision: The refusal of registration is affirmed.

³ Applicant's statement in its brief concerning the numerous third-party registrations which include the word "MAGIC" is unsupported by any evidence.